

REMARKS

Applicants have not amended any claims. In view of the following remarks, reconsideration of the outstanding Office Action is respectfully requested.

The present Office Action has rejected (i) claims 1-3, 5-11, 13-19, 21-28 and 39-50 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al. (Knight) in view of U.S. Patent Application No. 2002/0032735 to Burnstein et al. (Burnstein), (ii) claims 4, 12 and 20 under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Burnstein and further in view of U.S. Patent No. 6,651,086 to Manber et al. (Manber), and (iii) claims 35-38 under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Burnstein and further in view of U.S. Patent Application No. 2002/0059164 to Shtivelman (Shtivelman).

The present Office Action asserts that Knight clearly teaches a “tracking system that monitors and analyzes message content traffic from the subscribers and other source” and wherein the “information can also be used for adding modifying new groups and/or classes for subscriber message data items (See col. 6, lines 40-53). The present Office Action correctly notes that Applicants submit Burnstein is directed to matching users by the search strings they have provided, not by monitoring available documents in an information stream, but asserts that Knight clearly teaches that “ the tracking system monitors and analyzes message content traffic from the subscribers ... this routine preferably examines user query parameter, retrieved messages, user postings...” (See col. 6, lines 40-45). The present Office Action asserts that it would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Burnstein in the claimed invention of Knight in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]) and to help build connections amongst people and teams within the larger organization (See page 1, paragraph [0003]). The present Office Action asserts that (i) Knight teaches an online content provider system and method for compiling, creating and presenting content to users, (ii) Knight teaches an information monitoring device that monitors one or more electronic documents in an information stream associated with a first electronic forum, and compares information about the one or more electronic documents to one or more rules (See col. 9, lines 43-50 and col. 22, lines 35-44), and (iii) Knight teaches first kind of extraction robot of the present

invention periodically retrieve content from outside sources and online message board system, wherein the content is extracted from these sources according to set of rules, filters or criteria specified by the online provider, and/ or gleaned from community based traffic monitoring). The present Office Action correctly admits that Knight fails to teach a forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users, but goes on to assert that Burnstein teaches an automatic telephone, internet or intranet community formation that contacts the currently searching and the previously searching users and asks them if they want to join a new community on the topic of the search string, wherein, initially, the current searching user is contacted automatically and if that person indicates their interest in joining a community then the second action is to locate non-searching user(s) in the matched field and contact them and ask if they want to join this community and if each answers in the affirmative, automatically forming a new community with the users entered as members of that community (See page 8, paragraph [00981]). The present Office Action asserts that It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein in the claimed invention of Knight in order to invite the matched parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

Knight, Burnstein, Manber, and Shtivelman, alone or in combination, do not suggest or disclose, “an information monitoring device that monitors one or more electronic documents in an information stream associated with a first electronic forum, and compares information about the one or more electronic documents to one or more rules . . . a forum spawning device that queries a set of users participating in the first forum when at least one of the one or more rules is satisfied, and creates a new electronic forum based on one or more replies from the set of users” as recited in claim 1, “monitoring one or more electronic documents in an information stream associated with a first forum; comparing information about the one or more electronic documents to one or more rules; querying a set of users participating in the first electronic forum when at least one of the one or more ~~at least one~~ rules is satisfied; and creating a new electronic forum automatically based on one or more replies from the set of users” as recited in claims 9 and 17, or “an information monitoring

device for monitoring data associated with electronic documents in an information stream associated with a first electronic forum, the information monitoring device adapted to compare the data from the electronic documents according to a rule; and a forum spawning device for querying a set of users participating in the first electronic forum when the rule is satisfied, and for creating a new electronic forum based on one or more replies from the set of users” as recited in claim 26.

As disclosed on page 4, lines 3- 24 in the above-identified patent application, the present invention monitors an information stream associated with a first electronic forum with an information monitoring device. A set of users participate in the first electronic forum for example, by sending or receiving electronic documents over the information stream. Information about one or more of these documents is compared to one or more rules. If one of the rules is satisfied, a set of users who are participating in the first electronic forum are queried by the forum spawning device. Responsive to the replies from the queried users, the forum spawning device may create a new electronic forum. Thus, by way of example only, if members of a newsgroup started to post messages related to a topic that was determined (by a rule) to not be within the topic of the newsgroup, the invention would query users of the newsgroup whether a new newsgroup should be created. Responsive to the replies to the queries, the invention could generate a new newsgroup with the new topic

As set forth at col. 4, lines 56-67, Knight teaches (emphasis added) that:

“... there is an abundance of data online that would be of interest to broad classes of users, but no easy way to extract meaningful information, because it must be **manually** reviewed in inefficient ways. Accordingly, the creation of true collective intelligence electronic communities would be considerably enhances by a system that gathers and stores information from the community members **automatically** and intelligently, and then permits users in such community to be able to easily, flexibly and controllably glean and share selected insight from the experience, opinions, actions and facts from other users.”

Accordingly, it is of no surprise that the present Office Action correctly admits (emphasis added) that Knight fails to teach a forum spawning device that **queries a set of users** when at least one of the at least one rules is satisfied **and creates a new forum based on one or more replies from the set of users**, as Knight teaches away from any manual activity, such as requiring users replies, in order to create a fully automatic system. Thus, one of ordinary skill in the art would find no motivation to modify Knight to include **creating a new forum based on one or more replies from a set of users** based on such a teaching away therefrom by Knight.

As disclosed in paragraphs [0013], [0078], [0018], [0082], [0020], [0085], [0023], [0087], [0036], [0100], [0089], [0137], [0037], [0101], [0069], and [0138], Burnstein discloses tracking search strings, matching those who have used similar search strings, and proposing to those who have used similar search strings that they form a community (basically a news group). Burnstein assumes those who have made similar searches will have a common interest. Accordingly, Burnstein discloses matching users by the search strings they have provided, **not by monitoring available documents in an information stream**. Nothing in Burnstein suggests monitoring documents in a first electronic forum. Additionally, Burnstein does not teach querying a set of users who are participating in the first forum, but instead Burnstein discloses querying people who have provided similar search strings. Accordingly, even if Knight is considered in view of Burnstein as suggested by the present Office Action, it would not teach the claimed combination. Further, as noted above, there would not be any motivation for one of ordinary skill in the art to modify Knight to include **creating a new forum based on one or more replies from a set of users** based on such a teaching away therefrom by Knight other than by using impermissible hindsight after viewing the present invention. Like Knight and Burnstein, the other references cited by the present Office Action, whether taken alone or in combination, do not teach or suggest the claimed combination.

In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 9, 17, and 26. Applicants respectfully submit that claims 2-8, 27, 31, 35, 39-41 depend from and contain the limitations of claim 1, claims 1-16, 28, 32, 36, 42-44 depend from and contain the limitations of claim 9, claims 18-25, 29, 33, 37, 45-47 depend from and contain the limitations of claim 17, and

claims 30, 34, 38, and 48-50 depend from and contain the limitations of claim 26 and therefore are distinguishable over the cited references and are patentable in the same manner as claims 1, 9, 17, and 26 and on their own merits.

In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

NIXON PEABODY, LLP

/Carlos R. Villamar, Reg. # 43,224/

Carlos R. Villamar

Reg. No. 43,224

NIXON PEABODY LLP

CUSTOMER NO.: 22204

401 9th Street, N.W., Suite 900

Washington, DC 20004

Tel: 202-585-8000

Fax: 202-585-8080